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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,938	01/17/2002	Eugene R. Zehler	M 5850A-OS/LUAP	3048

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EXAMINER

KING, BRADLEY T

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

10/051,938

Applicant(s)

ZEHLER, EUGENE R.

Examiner

Bradley T King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 38-40,43,46,47,52-56,59,62-64,67-70,73 and 76-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 53,79 and 80 is/are allowed.
- 6) ☒ Claim(s) 38-40,43,46-48,52,55,56,59,62-64,67-70,73,76-78 and 81-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claims require a mixture of monocarboxylic and dicarboxylic acids having two or more C5, C6, C7 C8 and C9 linear monocarboxylic acids in combination with a hindered polyol and having at least %80 biodegradability . The specification fails to provide antecedent basis for these features.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 46-48, 62-64, and 76 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 46-51, 62-66, and 76

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(added in the amendment on 1/17/02) have limitations requiring a mixture of monocarboxylic acid and dicarboxylic which are not supported by the disclosure and are held as new matter.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 38-40, 43, 52, 54-56, 59, 67-70, 73, 77-78, and 81-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan et al in view of Funkhouser.

Duncan et al disclose biodegradable lubricants and further discloses a variety of applications including hydraulic fluids (see column 1, lines 30-33). The composition in table 8 (TPE/C810/Ck8) includes pentaerythritol with straight chained carboxylic acid component having 6-12 carbon atoms and a biodegradability of 92.9%. The carboxylic acid includes a mixture of linear C6 and C8 acids Funkhouser discloses all the features of the shock absorber including a cylinder 20 containing a fluid, a piston rod 26, a piston, first and second chambers and means for permitting fluid communication being disposed in at least a portion of the piston. Funkhouser remains silent as to the composition of the fluid within the absorber. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the fluid

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disclosed by Duncan et al with a shock absorber as taught by Funkhouser as an obvious implementation of the fluid which addresses environmental concerns with regards to leaking shock absorbers.

Regarding claims 40, 56, 70, 78, 82 and 84, Duncan et al disclose blends of trimethylolpropane with over 80% biodegradability in table 8.

Regarding claims 41, 57 and 71 Duncan et al suggest mono or dicarboxylic acids for linear acids and monocarboxylic acid for the branched acids.

Regarding claims 43, 59 and 73, the above mentioned composition contains branched C8 acids.

Regarding claims 52, and 67, see column 13, lines 26-45.

#### ***Allowable Subject Matter***

6. Claims 53, and 79-80 are allowed.

#### ***Response to Arguments***

7. Applicant's arguments filed 10/8/02 have been fully considered but they are not persuasive.

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Regarding the 112 1st paragraph rejection, the original disclosure (including the incorporation by reference) does not disclose the claimed combination of a mixture of monocarboxylic and dicarboxylic acids having two or more C5, C6, C7 C8 and C9 linear monocarboxylic acids in combination with a hindered polyol and having at least %80 biodegradability. Further, the original disclosure remains silent as to the biodegradability of such a mixture even though the biodegradability is explicitly claimed.

Regarding the 103 rejection, the limitations added to the independent claims are broader than the allowable subject matter indicated in the last office action.

### ***Conclusion***


8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley King whose telephone number is (703) 308-8346.

  
JACK LAVINDER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600  
1/13/03

BTK

January 13, 2003